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November 14, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: **Appeal No.:** 2007-0699
 Application No.: 08/889,033
 Confirmation No.: 2912
 Appellants: Frazzitta, et al.
 Title: Transaction System
 Docket No.: D-1083

Sir:

In response to the Decision dated September 21, 2007, please find enclosed a Request for Rehearing pursuant to 37 C.F.R. § 41.52 for filing in the above identified application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the Request and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 08/889,033)	
)	
In re Application of)	
Frazzitta, et al.)	
)	
Appeal No.: 2007-0699)	Art Unit 2621
)	
Confirmation No.: 2912)	
)	
Filed: July 7, 1997)	Patent Examiner Tung Vo
)	
Title: Transaction System)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING OF BOARD DECISION

Sir:

Appellants hereby request rehearing of the Decision dated September 21, 2007 by the Board of Patent Appeals and Interferences (hereinafter "Board") in Appeal No. 2007-0699 pursuant to 37 C.F.R. § 41.52.

**Points Believed To Have Been
Misapprehended Or Overlooked By The Board**

- Issue 1. Ramachandran (US 5,483,047) does not teach or suggest having an ATM supported by a wall. Thus, the Decision is in error.
- Issue 2. Ramachandran does not teach or suggest that the fascia (18) has a storage location for a supply of envelopes. Thus, the Decision is in error.
- Issue 3. The new grounds of rejection of claims 15-16 and 45-47 pursuant to 37 C.F.R. § 41.50(b) are legally improper. Thus, the Decision is in error.

The legal standard for review

Obviousness requires a showing of prior art knowledge of all recited features and relationships. In addition, before there can be a valid finding of obviousness, there must be some reason based on prior art knowledge to combine known features and relationships in the manner recited in the claim. *KSR International Co. v. Teleflex Inc.*, U.S., No. 04-1350, 4/30/07.

Issue 1

Each of the claims 4, 20, 28, 41, and 45 relate to a customer station frame being in supporting connection with a wall. Appellants presented arguments in support of this recited feature in their Appeal Brief.

The Decision regarding claims 4, 20, 28, 41, and 45 is based on Ramachandran teaching an ATM having a frame (40) that is supported by a wall. For example, the Decision states:

"The assembly 40 in Ramachandran is a frame" (Decision page 15 at lines 10-11, regarding claim 4);

"the assembly 40 in Ramachandran is a frame in an opening in a wall for a through-the-wall ATM. The assembly 40 has to be supported somehow by the wall" (page 20 at lines 1-4, regarding claim 20);

the "assembly 40 [which] must extend through and be supported by a wall in a through-the-wall ATM although the wall and the mounting are not expressly illustrated. It is not necessary for Ramachandran to disclose details that would be immediately evident to one of ordinary skill in the art" (page 23 at lines 15-19, regarding claim 28);

"As discussed in connection with claim 28, Ramachandran discloses a through-the-wall ATM where the assembly 40, which corresponds to a frame, fits in an opening in the wall and is in supporting connection with the wall" (page 29 at lines 6-9, regarding claim 41); and

"Ramachandran discloses mounting components for a customer station on a frame (assembly 40) in a wall opening in supporting connection with the wall for a through-the-wall configuration" (page 35 at lines 19-21, regarding claim 45).

Appellants respectfully challenge the Decision-based assertion that Ramachandran teaches an ATM frame (40) supported by a wall. There is no prior art teaching or suggestion of record for having an ATM supported by a wall.

The Board admits (Decision page 23 at lines 15-19) that "the wall and the mounting are not expressly illustrated" in Ramachandran. Yet, in spite of the admitted lack of concrete evidence of record for the feature, rejections were affirmed merely on the feature being alleged.

Appellants respectfully submit that there are good reasons why the feature relied upon by the Board is not illustrated in Ramachandran. One having ordinary skill in the ATM art would recognize that in a through-the-wall arrangement the ATM is supported by a floor (behind the wall). The wall does not support the ATM. A wall also provides security for the rear area of the ATM, at which bank employees can service the ATM unseen. Nor has the Board explained how a weak cosmetic wall could support the enormous weight of a conventional ATM.

The Decision is based on unfounded speculation that has no support whatsoever in the record. It is well established that an assertion not based on any evidence in the record lacks substantial evidence support and is not a legal basis for rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

The burden is the Office (or the Board) to establish a *prima facie* case of obviousness under the law. Clearly, this burden has not been met. Thus, Appellants respectfully submit that the Decision is in error with regard to at least claims 4-5, 7-9, 20-23, 28-37, 41-42, and 45-46.

An Affidavit Regarding Personal Knowledge Is Requested

As previously discussed, neither Ramachandran nor the record teaches or suggests the feature relied upon by the Board. As a result, the Decision must be drawing reliance on personal

knowledge of the ATM art to support the bold assertion that it is so "immediately evident" (Decision page 23 at lines 15-19) to have an ATM supported by a wall that it is "not necessary for Ramachandran to disclose details" thereof (page 23 at lines 15-19). Fortunately, the law does not permit the Board to skip the "details." Thus, Appellants hereby respectfully request an affidavit from the Board according to the provisions of 37 C.F.R. § 1.104(d)(2).

Issue 2

Claim 11 recites that "the cover includes at least one storage location, wherein articles are enabled to be stored in the storage location." The Decision states that "Ramachandran discloses that 'the fascia panel may have other openings and/or components accessible therethrough, such as . . . a supply of depository envelopes' (col. 4, lines 53-55). If there is a supply of envelopes in the fascia (cover), there must be a storage location" (Decision page 19 at lines 9-13).

The Board's reasoning constitutes a new ground of rejection with regard to claim 11

The record shows that the rejection of claim 11 was appealed because it was based on Ramachandran allegedly teaching a storage location (28). The Appellants argued that the relied upon element (28) in Ramachandran was not a storage location, but rather a door. The Board apparently agreed with Appellants' argument.

However, for the first time in the record, the Office (Board) newly relies on Ramachandran for having a fascia panel with a storage location for a supply of envelopes. Appellants respectfully submit that their Appeal Brief arguments against the claim 11 rejection were directed to a feature in Ramachandran which was solely relied upon in the rejection from which appeal was taken. The Board raises new issues, new interpretations, and new applications of the reference. Thus, the Board's new reliance on a different feature in Ramachandran to support the rejection constitutes a new ground of rejection.

The Office cannot make a rejection based on an issue and then, following refuting arguments in an appeal of that issue, rely on a completely new issue to maintain the rejection. With regard to administrative due process rights, Appellants have not been given fair opportunity to address the newly relied upon issue. As a result, the Board's affirmation of the claim 11 rejection is legally improper.

The Board misapplies the teaching of Ramachandran

Furthermore, the newly relied upon interpretation of Ramachandran by the Board is misguided. The new rejection relies on the section (col. 4, lines 53-55) of Ramachandran which states that "the fascia panel [18] may have other openings and/or components accessible therethrough, such as a camera or a supply of depository envelopes." So? How does a fascia having an opening through which a customer can reach to access envelopes stored behind the fascia constitute a fascia having a storage location in which a supply of envelopes is stored?

The Board misinterprets (or attempts to redefine) Ramachandran's fascia "openings." How can an item be stored in an access (through) opening? For example, Ramachandran teaches that the fascia (18) has a receipt delivery opening (26); a deposit accepting opening (30); and the screen opening (62) (e.g., Figure 1). In which of these openings is there a storage location for items? Are deposits stored in the deposit opening (30)? Are display screens stored in the screen opening (62)? Rather, Ramachandran teaches (e.g., col. 6, lines 1-4) that the screen opening (62) merely provides visual "access" to the screen (22). The screen opening (62) does not store an item, else a technician would not be able to extend his head through the opening (62) during servicing of components located behind the fascia (e.g., col. 6, lines 1-4).

Thus, Ramachandran teaches away from the Board's allegation that the fascia panel (18) has a deposit envelope opening which comprises a storage location in which deposit envelopes are stored. The record is absent evidence that Ramachandran teaches that the fascia (18) itself has a storage location in which a supply of deposit envelopes is stored, as alleged by the Board.

Even if it were somehow possible (which it isn't) for the Board's newly relied upon features in Ramachandran not to constitute a new ground of rejection, the rejection would still be legally improper because Ramachandran does not teach or suggest the newly relied upon features. Again, the Board's affirmation of the claim 11 rejection is legally improper.

Appellants respectfully submit that the affirmation of the claim 11 rejection is improper for the reasons that the rejection is new and the basis therefor is without support. Thus, Appellants respectfully submit that the Decision is in error with regard to at least claim 11.

Issue 3

Claims 15-16 were newly rejected over McClure, Granzow, and Gallacher pursuant to 37 C.F.R. § 41.50(b).

Claims 45-47 were newly rejected over McClure, Ramachandran, and Granzow pursuant to 37 C.F.R. § 41.50(b).

The new rejections depend on modification of McClure in view of either Gallacher (claims 15-16) or Ramachandran (claims 45-47). However, the teaching of McClure is not compatible with the teaching of Gallacher or Ramachandran.

The decision confuses Gallacher's ATM and Ramachandran's ATM with the teaching of McClure. McClure is directed to a drive-through banking arrangement which requires a bank teller to manually perform a transaction. McClure is not directed to an automated ATM, as the

rejections infer. Nor does McClure teach or need the features of an ATM. One skilled in the art would not have considered modifying McClure with ATM features, especially in the manner alleged by the Board. The rejections are at best attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure.

Additionally, for reasons already discussed with regard to Issue 1, the new grounds of rejection of claims 45-46 should be withdrawn because they are legally improper due to lack of evidence of an ATM-supporting wall.

Conclusion

Appellants have shown herein that there are several points that have been misapprehended or overlooked by the Board in its Decision. As a result, it is respectfully submitted that the Decision should be withdrawn and the rejections of at least claims 4-5, 7-9, 15-17, 20-23, 28-37, 41-42, and 45-47 should be reversed.

Respectfully submitted,



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